

REMARKS/ARGUMENTS

The Applicants respectfully request further examination and consideration in view of the amendments above and the arguments set forth fully below. Claims 1-4, 6-10, 12, 13, 15-21, 23, 27-30, 34-36, 40, 41, and 43-51 are pending in this application. Claims 1-4, 6-10, 12, 13, 15-21, 23, 27-30, 34-36, 40, 41, and 43-51 stand rejected under 35 U.S.C. 103(a). By the above amendments, claims 46, 48, and 49 are amended. Accordingly, claims 1-4, 6-10, 12, 13, 15-21, 23, 27-30, 34-36, 40, 41, and 43-51 are currently pending in this application.

CLAIM REJECTIONS UNDER 35 U.S.C §103(a)

1. Within the Office Action, claims 1-4, 6-10, 12, 13, 15-21, 23, 27-30, 34-36, 40, 41, and 43-51 are rejected under § 103(a) as being unpatentable over the article titled “recommend-it.com” (hereinafter “recommend-it”) in view of “How MileNet Works” (hereinafter “MileNet”). The Applicants respectfully traverse this rejection.

Recommend-it teaches a service whereby a first user can recommend a website to a second user. The recommendation comes in the form of an email sent by the recommend-it service to the second user. The email includes the name of the first user, the URL and brief description of the website recommended by the first user, and an optional personal message from the first user. To initiate the recommendation, the first user completes a form provided by the recommend-it service. The form is accessed by clicking a related button included on the recommended website. The first user provides their name and email address, the email address of the second user, and the optional personal annotation to the second user.

The independent claim 1 is directed to a method of marketing comprising the steps of: a.) offering a reward to a first party in exchange for a recommendation of a marketable entity, the recommendation comprising a forwarding of a first e-mail message to a second party, the first e-mail

message comprising a personalized referral for the marketable entity and a first set of data, the first set of data comprising a first serial number and a first URL link to a first Web site having an offer to transact an exchange for the marketable entity; b.) correlating the first set of data in the first e-mail message to data within a database, the data within the database comprising data relating to the reward offered to the first party; c.) updating the database with an e-mail address of a second party provided by the first party; d.) forwarding the first e-mail message to the e-mail address of the second party, wherein the marketable entity is selected from a group consisting of goods and services; and e.) providing the reward to the first party if the second party transacts the exchange for the marketable entity.

10 There is no hint, teaching, or suggestion that the recommendation service of recommend-it includes any offer to transact an exchange, as claimed. The Examiner cites page 2 of recommend-it and states that the first user of recommend-it will send an e-mail to a friend or colleague detailing the site and would include a short description identifying the website, a link to the website and a personal annotation. However, there is no mention of an offer to transact an exchange for a marketable entity, 15 where this offer is included in the actual recommendation. The Examiner cites page 1 of recommend-it and states that different categories of websites are available that offer different brands or goods. This way be so; however, the recommendation itself does not include any offer to transact an exchange for a marketable entity. As such, recommend-it does not teach a recommendation that includes an offer to transact an exchange where the offer is included within the recommendation itself, as claimed.

20 Further, within the Advisory Action, the Examiner states that the word “transact” merely means an activity involving two parties and in recommend-it, the first user recommends to “WebDeck software” as being the marketable entity, and the website and the second user transact or perform an activity such as logging on to the website to view the content of the site and the software recommended. In contrast, the present claims are directed to transacting an exchange for the marketable entity. Even if

recommend-it teach a transaction as cited by the Examiner, the cited transaction does not teach an exchange for the marketable entity, as claimed.

Still further, there is no hint, teaching, or suggestion that the recommendation service of recommend-it includes offering a reward for the recommendation, as claimed. The Examiner contends that the promotional newsletter offered by recommend-it is the same as the claimed reward. However, element (a) of claim 1 includes “offering a reward to a first party in exchange for a recommendation of a marketable entity.” Recommend-it does not teach that the promotional newsletter is in exchange for recommending the website. The Examiner cites the recommendation form on page 2 of recommend-it because the recommendation form includes an option for the first user to receive the promotional newsletter. Although this option is presented on the same form that the first user fills out to recommend the website, the promotional newsletter is not an actual reward for making the recommendation because the promotional newsletter can be received regardless of whether the first user makes the recommendation. Specifically, recommend-it teaches on page 1, lines 10-12 that the promotional newsletter is available for free and that the newsletter can be obtained independent of the recommendation, as indicated by the “Sign up Today!” link on page 1, lines 11-12. Therefore, inclusion of the option to receive the promotional newsletter within the recommendation form is merely a cross-marketing opportunity. Recommending the website and receiving the newsletter are mutually exclusive. Accordingly, recommend-it does not teach offering a reward in exchange for a recommendation.

In summary, recommend-it does not teach a recommendation that includes an offer to transact an exchange where the offer is included within the recommendation itself, recommend-it does not teach an exchange for the marketable entity, and recommend-it does not teach offering a reward in exchange for a recommendation. MilesNet is not cited as teaching any of these limitations. As such, neither recommend-it, MilesNet, nor their combination teach the claimed limitations. For at least these

reasons, the independent claim 1 is allowable over recommend-it in view of MilesNet.

Claims 2-4, 6-10, 12-13, 15-21, 23, 27-30, 34-36, 40-41, and 43-45 depend from independent claim 1. As discussed above, claim 1 is allowable over recommend-it in view of MilesNet. As such, the dependent claims 2-4, 6-10, 12-13, 15-21, 23, 27-30, 34-36, 40-41, and 43-45 are also allowable as being dependent on an allowable base claim.

5 Similarly, independent claim 50 is allowable over recommend-it in view of MilesNet for at least the same reasons as described above in regard to claim 1. Claim 51 depends from the independent claim 50. As such, claim 51 is allowable as being dependent upon an allowable base claim.

10 2. By the above amendments, the independent claim 46 is amended to include the limitations “transacting a purchase for a first marketable entity by a first party, offering a reward to the first party in exchange for a recommendation of a second marketable entity substantially similar to the first marketable entity to a second party wherein the recommendation results in a purchase transaction, and forwarding an e-mail to a second party, the e-mail comprising the recommendation for the second marketable entity by the first party, an e-mail address of the first party, and a URL link to a Web site having an offer to transact a purchase for the second marketable entity, wherein the first marketable entity and the second marketable entity are selected from a group consisting of goods and services.”

15 (Emphasis added) There is no hint, teaching, or suggestion in either recommend-it of MilesNet of the first party first purchasing the marketable entity and then recommending the purchased marketable entity. As such, the amended independent claim is allowable over recommend-it in view of MilesNet.

20 Claims 47-49 depend from the independent claim 46. As discussed above, the amended independent claim 46 is allowable over recommend-it in view of MilesNet. As such, the dependent claims 47-49 are also allowable as being dependent on an allowable base claim.

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3. Within the Office Action, claims 6, 17-18, 20-23, 28-29, and 36 are rejected under § 103(a) as being obvious over recommend-it. In regard to claims 6, 17-18, and 20, Official Notice is taken that it is old and well known in the computer related field to have a token in the form of an icon that is visible in the message in order to represent a function, object, or program, and that it would have been obvious to a person of ordinary skill in the art to have included a token in the form of a first icon visible in the message in order to make file navigation and manipulation easier. In regard to claims 21-23, 28-29, and 36, Official Notice is taken that it is old and well known in the business related arts to credit an account because such a modification would provide an easy and efficient way to reward a customer, and that is would have been obvious to a person of ordinary skill in the art to have included crediting an account within a database and recording the reward credited in order to obtain the above mentioned advantage. The Applicants respectfully traverse the USPTO's Official Notice as to claims 6, 17-18, 20-23, 28-29, and 36. Applicants demand for evidence, including standard references and prior art references, upon which the USPTO rely to support the taking of said Official Notices. Applicants respectfully request that the data be stated as specifically as possible, pursuant to MPEP §2144.03.

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CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. If the Examiner believes that a telephone conference would expedite prosecution of this application, the Examiner is encouraged to contact the undersigned at (408) 530-9700.

Respectfully submitted,

HAVERSTOCK & OWENS LLP

By: Thomas B. Haverstock

Thomas B. Haverstock

Reg. No. 32,571

Attorneys for Applicant

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CERTIFICATE OF MAILING (37 CFR § 1.8(a))
I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450

Date: 3/28/07 by M. Helman
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